

REMARKS

Entry of the foregoing, and reconsideration and further examination of the subject application, in view of the amendments above and the remarks below, are respectfully requested.

Status of Claims

By the above amendments, claim 1 has been amended to specify that the stained portion of the substrate comprises a mark, discoloration, or deposit. Support for this amendment may be found in the specification such as at page 8, lines 9-10. In addition, claim 69 has been deleted without prejudice or disclaimer. Thus, upon entry of the foregoing amendments, claims 1-68 and 70-72 will remain pending in the application. Of these, only claims 1-21, 47-50, and 70 are under consideration. The remaining claims stand withdrawn as being directed to a non-elected invention.

Election/Restriction

In the Office Action, claims 1-21, 47-50, and 69-70 were restricted from claims 22-46, 51-68, and 71-72 as being directed to distinct inventions.

Applicants hereby confirm the election of the invention of Group I (claims 1-21, 47-50, and 69-70) for examination. However, the election is made with traverse.

MPEP § 803 states that an application may be properly restricted to one or more claimed inventions only if (1) the inventions are independent or distinct as claimed, and (2) there is a serious burden on the Examiner if restriction is not required. Thus, even if appropriate reasons exist for requiring restriction, such a requirement should not be made unless there is an undue burden on the Examiner to examine all the claims in a single application. Here, it would appear that the searches involved for the claims would be coextensive. As such, it is not believed to be a serious burden on the Examiner to examine all the claims.

Accordingly, for at least all of the reasons set forth above, withdrawal of the restriction requirement is requested.

Claim Interpretation

The Examiner interpreted the word “stain” in claims 1 and 69 to include “holes, blemishes, cracks, and other minor surface imperfections.” This interpretation, however, is no longer justified in light of the amendment to claim 1.

Claim Rejections – 35 U.S.C. §§ 102 and 103

Claims 1, 3-8, and 69-70 were rejected under 35 U.S.C. § 102(e) as being anticipated by Swanson (U.S. Patent No. 6,607,621). Claims 2 and 47-50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Swanson in view of Reed (U.S. Patent No. 3,432,376). Claims 9-21 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Swanson in view of Shih (U.S. Patent No. 5,891,294). For the following reasons, these rejections should be withdrawn.

First, all of the rejections were premised on the Examiner’s interpretation that “stain” in claims 1 and 69 includes holes and cracks. As mentioned above, this interpretation is no longer justified. Claim 1 has been amended to specify that the stained portion comprises a mark, discoloration, or deposit. Swanson does not disclose or suggest each feature of amended claim 1. For example, Swanson does not disclose or suggest contacting a stained portion of a substrate with a dry film layer where the stained portion includes a mark, discoloration, or deposit. Swanson only discloses a wall patch to cover holes or cracks in a wall. Col. 2, lines 39-40. There’s no mention of using the patch to cover marks, discolorations, or deposits; or the unique problems associated with such stains. See the present application at page 1, line 14 to page 4, line 17. Thus, Swanson fails to disclose or suggest each feature of amended claim 1 or its dependent claims.

Second, Reed and Shih do not remedy the deficiencies of Swanson. In fact, they cannot be properly combined with Swanson. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to combine the reference teachings. MPEP § 2143.01 at 2100-129 (Rev. 2, May 2004). Here, there is no requisite suggestion or motivation. As noted above, Swanson is directed to a wall patch to cover holes or cracks in a wall. In contrast, Reed is directed to a dry transfer sheet for use as a photomechanical tint, a mask over a photograph or drawing, a photographic

mask, gold effects, a color trim, thermosetting transfers, ceramic transfers, a screen printing stencil, or an etching resist. Col. 8, line 62 to col. 9, line 43. Reed does not mention covering holes or cracks in a wall. Likewise, Shih discloses a stain blocking barrier layer. There's no mention of covering holes or cracks in a wall. Thus, there's no suggestion or motivation to combine the teachings of Swanson with those of Reed or Shih.

Accordingly, there is no *prima facie* case of obviousness, let alone one of anticipation. As a result, the rejections under §§ 102(e) and 103 should be withdrawn.

Conclusion

In summary, Applicants believe the application to be in condition for allowance. Accordingly, the Examiner is respectfully requested to reconsider the rejection(s), remove all rejections, and pass the application to issuance.

Respectfully submitted,

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